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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,633	12/08/2003	Philip E. Eggers	NET 2-100	4273
266 7590 01/16/2008 MUELLER AND SMITH, LPA MUELLER-SMITH BUILDING 7700 RIVERS EDGE DRIVE COLUMBUS, OH 43235			EXAMINER HOEKSTRA, JEFFREY GERBEN	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 01/16/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/730,633

Applicant(s)

EGGERS ET AL.

Examiner

Jeffrey G. Hoekstra

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 13-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Notice of Amendment*

1. In response to the Appeal Brief filed on 10/29/2007, the current rejections of claims 1-12 are withdrawn. The following new and reiterated grounds of rejection are set forth:

#### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is

shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3-4, and 12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 8, 15-17, 20, 22, and 23 of U.S. Patent No. 6,471,659 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims positively recite the as claimed structural limitations of the instant case although the elements are referenced with a different name, for example the support member of the instant case is claimed as a delivery cannula.

4. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,923,809 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case is merely a broader recitation of the patented claims.

5. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,955,653. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case is merely a broader recitation of the patented claims.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 8, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by McGuckin, J. r. et al. (US 6,626,903 B2, hereinafter McGuckin).

8. For claims 1-3, 7, 8, 11, and 12, McGuckin discloses an electrosurgical cutting apparatus (10 and 100), comprising:

- a support member (12) having an internal channel and extending to a forward region (as best seen in Figure 1A);
- a tissue capture component positioned within said interior channel, comprising:
  - a plurality of elongate thin leafs (160) extending forwardly from a base portion to a leaf tip region (as best seen in Figure 6B), a said leaf having a resilient metal drive component (170) extending along a leaf axis from said base portion to a tip region and having a first width at said base portion extending at least to a guide commencement location and configured to define a protective aperture extending across said guide outlet at said tip region,
  - an electrically-insulative, polymeric, flexible leaf cable guide (150) component comprising a sheath (as best seen in Figures 6B and 24) and having one or

more guide channels (the lumens of elements 150), reinforced in the vicinity of said guide outlet, disposed parallel with said leaf axis, extending to a guide outlet (the proximal opening of lumen of elements 150), and configured to surround one or more cables of a pursing cable assembly between said guide outlet and said guide commencement location (as best seen in Figure 22 and 24),

- an integrally formed coupling portion (170) mounted with said drive component,
- said guide channel extending from said tip region along said drive component to said guide commencement location,
- said leaf assembly being moveable to deploy outwardly from said support member forward region (as best seen in Figures 4A-9B), and
- said capture component having a pursing cable (186) assembly extending through said cable guide component guide channel and said guide outlet, electrosurgically energizable and deployable with each said leaf tip region (column 9 lines 62-65) (as best seen in Figures 22 and 24);
- a drive assembly (20, 30, and 40) engageable with said leaf assembly base portion and said pursing cable assembly and actuable to move said leaf assembly to deploy outwardly from said support member while effecting said deployment of said pursing cable assembly (column 7 lines 3-63); and

- a control assembly (column 9 lines 53-57) drivably engageable with said drive assembly to effect said actuation thereof and having a terminal electrically coupled with said cable assembly to effect the electrosurgical energization thereof.

9. For claim 4, McGuckin discloses an electrosurgical cutting apparatus (10 and 100), wherein said leaf drive component has a first width is defined between oppositely disposed edges extending from said base portion to said guide commencement location, and is configured having a second full width less than said first width extending from said guide commencement location to said tip region and defining with said first width oppositely disposed shoulders at said guide commencement location (as best seen in Figure 2B); and said leaf cable guide coupling portion is configured having oppositely disposed rearward end surfaces at said guide commencement location extending in abutable support before said oppositely disposed shoulders (as best seen in Figure ).

10. For claim 5, McGuckin discloses an electrosurgical cutting apparatus (10 and 100), wherein said leaf drive component is configured having at least one serrated edge (column 10 lines 53-64) with rearwardly directed points configured to engage said leaf cable guide component coupling portion when said leafs are moved rearwardly from a deployed orientation toward said support member.

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin. McGuckin discloses the claimed invention but does not disclose expressly the dimensions and material compositions of the leaf cable drive and guide components. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the electrosurgical cutting apparatus as taught by McGuckin et al with the claimed dimensions and polymer, because Applicant has not disclosed that the dimensions and particular polymer provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with dimensions and materials of the electrosurgical cutting apparatus as taught by McGuckin, because it provides a means to electrosurgically dissect, encapsulate, and remove tissue and since it appears to be an arbitrary design consideration which fails to patentably distinguish over McGuckin. Therefore, it would have been an obvious matter of design choice to modify McGuckin to obtain the invention as specified in the claim(s).

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.



Application/Control Number:  
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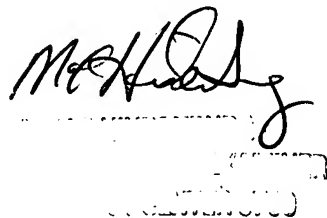
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./

Jeff Hoekstra  
Examiner, Art Unit 3736



Max F. Hindenburg  
Supervisor